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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,001	01/09/2001	Christopher C. Burger	CPL1538-196	8540
8698	7590	07/13/2004	EXAMINER	
STANDLEY LAW GROUP LLP 495 METRO PLACE SOUTH SUITE 210 DUBLIN, OH 43017			VO, HAI	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/758,001	Applicant(s) BURGER ET AL.	
	Examiner Hai Vo	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0105</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. All of the art rejections in the 11/25/2003 Office Action are maintained.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, and 6-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stucky et al (US 6,344,268) in view of Deaner et al (US 5,486,553) substantially as set forth in the 11/25/2003 Office Action. The art rejections are repeated for the following reasons. Applicants argue that by comparing the examples provided in Table I of Stucky et al, it can be seen that varying the amount of wood flour in the foam composite affects the flex modulus and flex strength of the composite. Applicants then conclude the Stucky reference provides evidence that a significant amount of wood flour would materially change the novel characteristics of the foamed polymer layer of the present invention. The arguments are not commensurate in scope with the specification and therefore not found to be persuasive for patentability. Nothing in Applicants' specification discloses or suggests the flex modulus and flex strength are the novel or basic characteristics of Applicants' invention. Therefore, the evidence that the addition of the wood flour in the foam composite materially affecting the flex modulus and flex strength of the foam composite is found irrelevant to Applicants' specification. It is noted that

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support for a negative limitation "the foamed polymer composition may not include any inorganic filler or cellulosic filler" is found in the specification. The examiner suggests that incorporation of the negative limitation in the claims is sufficient to overcome the art rejections over Stucky. Further, Applicants argue that Stucky does not disclose the amount of lubricant and stabilizer. Again, as previously discussed in the 11/25/2004 Office Action, discovering the optimum or workable ranges for the amounts of lubricant and stabilizer involves only routine skill in the art. Therefore, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the lubricant and stabilizer having the amounts instantly claimed motivated by the desire to facilitate the processing and thermally stabilize the composite material. This is in line with *In re Aller*, 105 USPQ 233 which holds discovering the optimum or workable ranges involves only routine skill in the art. Finally, Applicants argue that Deaner does not overcome the deficiencies of Stucky. Deaner does not provide any motivation to produce a component comprising a synthetic wood layer and foamed polymer layer as recited in the claims. The examiner disagrees. Stucky teaches a composite material for use in door and window sills and sashes comprising a foamed polymer layer and a synthetic wood layer being co-extruded onto the foam layer (column 3, lines 5-10). Stucky teaches the synthetic wood layer comprising a polymeric resin filled with wood fiber to provide a wood-like appearance (column 3, line 9). Stucky discloses the foam layer comprising 35 to 75 wt % PVC or polypropylene, 25

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to 65 wt % wood fiber, 1.5 parts of blowing agent per 100 parts of PVC, 7 parts of acrylic processing aid per 100 parts of PVC and a small amounts of lubricant and stabilizer (column 4, lines 8-10, tables I, II). Stucky discloses the synthetic wood layer comprising a polymeric resin, wood filler and additives but does not specifically disclose the amount of individual component in the synthetic wood layer. Therefore, it is necessary and thus obvious for the skilled artisan to look to the prior art for the suitable amount of each individual component. Deaner teaches a polymer/wood composite material for use in door and window sills and sashes comprising 50 wt% PVC, 50 wt% wood fiber (table I) wherein the PVC resin comprising 100 parts of PVC, 1.5 parts calcium stearate stabilizer, 2 parts of lubricant, 7.5 parts acrylic resin process aid within the claimed ranges (column 8, lines 35-45). Deaner teaches that the composition provides the polymer/wood composite material having a high modulus, high compressive strength, low thermal transmission and improved resistance to insect attack and rot (column 2, lines 15-25), which is important to the invention of Stucky and thus suggesting the modification. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the synthetic wood layer having the composition as taught in Deaner motivated by the desire to provide the composite material having a high modulus, high compressive strength, low thermal transmission and improved resistance to insect attack and rot. It is believed that the motivation to combine the two

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cited references is sufficient and strong. Accordingly, the art rejections are sustained.

4. Claims 4, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stucky et al (US 6,344,268) in view of Deaner et al (US 5,486,553) as applied to claim 1, as evidenced by Zehner et al (US 5,866,264) substantially as set forth in the 11/25/2003 Office Action. The same reasons set forth in the paragraph no. 3 are believed to be pertinent.
5. Claims 14, 15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhams (US 5,474,722) substantially as set forth in the 11/25/2003 Office Action. The art rejections have been maintained for the following reasons. Applicants argue that the component taught by Woodhams is made from a foam core surrounded by a solid skin of the same composite compound while the component of the present invention is comprised of two different material layers secured together. The arguments are not commensurate in scope with the claims. The "foamed propylene layer" does not exclude an embodiment wherein the polypropylene foam layer can include at least one stabilizer, and at least one cellulosic filler (the last paragraph at page 11 of the specification). Therefore, the component as presently claimed does not exclude the rod of Woodhams. Accordingly, the art rejections are sustained.
6. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhams (US 5,474,722) as applied to claim 14 above, as evidenced

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by Zehner et al (US 5,866,264). The same reasons as set forth in the paragraph no. 5 are believed to be pertinent.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Woodhams (US 5,474,722) as applied to claim 14 above, in view of Godavarti et al (US 6,265,037). The same reasons as set forth in the paragraph no. 5 are believed to be pertinent.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 14, 15, 18-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 and 5 of U.S. Patent No. 6,579,605 in view of Woodhams (US 5,474,722) substantially as set forth in the 11/25/2003 Office Action. The double patenting rejections have been maintained for the following reasons.
- Applicants argue that the present application was filed on January 09, 2001 while US Application No. 09/854,894, which issued as US Patent No.

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6,579,605, was subsequently filed on May 14, 2001. Therefore, the double patenting rejections have been obviated. The arguments are not found persuasive for patentability. The double patenting is made to prevent the improper extension of patent exclusivity beyond the term of the patent and to prevent possible harassment by multiple assignees. The examiner respectfully points out that the double patenting is completely different from the prior art and certainly not excluded by the later filing date as argued by Applicants. The double patenting rejection will be overcome only by the submission of the terminal disclaimer.

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571)

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272-1485. The examiner can normally be reached on M,T,Th, F, 7:00-4:30 and on alternating Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HV


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SUPERVISORY PATENT EXAMINER
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